

### **REMARKS**

The Office Action dated March 16, 2007, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 1 has been amended. No new matter is presented. Claims 1-5 are pending and respectfully submitted for consideration.

#### **Entry of Response Proper**

Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issues requiring further search and/or consideration on the part of the Examiner as the Amendment merely clarifies the claimed features of the invention; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to objections raised in the Final Rejection. Entry of the Amendment is thus respectfully requested.

#### **Rejection Under 35 U.S.C. § 112**

Claims 1-5 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Office Action stated that it is not known what is being referred to as "a single unbroken member". The Applicant respectfully submits that the cable is the single unbroken member as shown in Fig. 2 of the specification of the present application. The Applicant has amended claim 1 to clarify this feature of the

invention. As such, the Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

**Rejection Under 35 U.S.C. § 102**

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Inoue et al. (U.S. Patent No. 4,347,651 "Inoue"). The Applicant traverses the rejection and respectfully submits that claims 1-3 recite subject matter that is neither disclosed nor suggested by Inoue.

Claim 1, as amended, recites a process for mounting a plurality of parts to a cable comprising mounting the plurality of parts to the cable, the cable being a single unbroken member, in mounted position and mounted attitudes. The mounted positions are intermediate between opposite longitudinal ends of the cable in a state where the cable is used. The mounted positions and the mounted attitude are determined respectively for the parts. The cable is marked with information for the mounting of each of the parts before the mounting of the parts.

The Office Action asserted that terminals 18E and 18F in Inoue were comparable to the claimed plurality of parts and that the wire 20B was comparable to the claimed cable. Specifically, the Office Action asserted that "(note the ends of the cable is exposed outside the parts)". See page 3, lines 6-7 of the Office Action. In contrast, Inoue disclose "press connecting of the terminals to the ends of the wire". See col. 6, lines 12-13 of Inoue. See also Fig. 6 of Inoue which shows the wire 20B connected to terminals 18E and 18F which are disclosed at opposite ends of the wire 20B. As Inoue shows and specifically states that the terminals are connected to the end of the wire, Inoue does not disclose or suggest that the mounted position of the parts are

intermediate between opposite longitudinal ends of the cable in a state where the cable is used, as recited in claim 1.

Further as Inoue discloses that the terminals are press-connected to the wire 20B from the lateral side of the wire 20B, the reference does not disclose or suggest that a plurality of parts at mounted positions being intermediate between opposite longitudinal ends of the cable in a state where the cable is used, as recited in claim 1. Accordingly, the Applicant respectfully requests withdrawal of the rejection of claim 1.

With respect to claim 2, the Applicant respectfully submits that Inoue fails to disclose or suggest the claimed features of the invention. Claim 2 recites that the step of marking the cable with information for mounting each of the parts comprises marking the cable with a name, the mounted position and the mounted attitude of each of the parts. As discussed in the previous Response filed December 19, 2006, the mounted attitude refers to the orientation of the parts and the cable. The Office Action asserted that col. 1, lines 16-19 of Inoue discloses this feature of the invention. However, col. 1, lines 16-19 merely states that "wire connecting information 3A designates a wire number; 3B a connecting device position; 3C the terminal number of the connecting device". There is no disclosure or suggestion in Inoue of marking the cable with information for mounting each of the parts comprises marking the cable with the mounted attitude of each of the parts. As such, the step of marking the cable with the mounted attitude of each of the parts is missing from Inoue. Therefore, Inoue does not disclose or suggest the features of the invention as recited in claim 2.

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Cross (U.S. Patent No. 5,153,839). The Applicant traverses the rejection and respectfully

submits that claims 1-3 recite subject matter that is neither disclosed nor suggested by Cross.

Cross discloses a manufacturing system including a wire segment preparation subsystem and a termination system, each of which operates independently under the direction of local computer controllers. The preparation subsystem measures and marks wire and cuts it into segments. The termination subsystem processes the end of the wire segments. The wire segments are hung on dividers in the carrier or are individually coiled onto reelettes which are in turn loaded in the carrier. See the Abstract of Cross. Cross further discloses that the system is for manufacturing aircraft wire harnesses. See col. 2, lines 1-2 of Cross. In the subsystem, each wire segment needed for the fabrication of a harness is dereeled from a continuous source, measured, marked, cut and coiled. See col. 8, lines 23-25 of Cross.

The Applicant respectfully submits that Cross fails to disclose or suggest the features of the invention as recited in claims 1-3. Claim 1 recites mounting a plurality of parts to the cable. The Office Action asserted that Cross discloses mounting a plurality of parts "(harness, terminator See col. 9, lines 46-47)" to the cable (see Fig. 6). See page 3, lines 20-21 of the Office Action. In contrast, Cross discloses manufacturing a harness, not mounting a harness, as discussed above. Further, col. 9, lines 46-47 of Cross merely states that each wire is marked with alphanumeric character 68 that corresponds to a part number. There is no disclosure or suggestion in Cross that a part is mounted at the part number, as recited in claim 1. Further, Fig. 6 of Cross does not show parts mounted to the wire at a part number. As such, Cross does not disclose or suggest the features of the invention as recited in claim 1.

With respect to claim 2, Cross fails to disclose or suggest the claimed features of the invention. As discussed above, claim 2 recites that the step of mounting the cable with information for mounting each of the parts comprises mounting the cable with a name, the mounted position and mounted attitude of each of the parts. The Office Action asserted that Cross discloses this feature in col. 9, lines 45-47. See page 4, lines 6-7 of the Office Action. However, as discussed above, the recited section of Cross merely discloses that each wire is marked with an alphanumeric character that corresponds to a part number. There is no disclosure or suggestion of the wire being marked at the mounted position and mounted attitude of each of the parts. As such, Cross fails to disclose or suggest the features of the invention as recited in claim 2.

To qualify as prior art under 35 U.S.C. § 102, each and every feature recited in a rejected claim must be disclosed by the applied art. Accordingly, Inoue and Cross do not anticipate claim 1, nor is claim 1 obvious in view of Inoue and Cross. Therefore, the Applicant submits that claim 1 is allowable over Inoue and Cross.

### **Rejection Under 35 U.S.C. § 103**

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cross in view of Okamoto et al. (U.S. Patent No. 6,267,385 B1, "Okamoto"). Cross was cited for disclosing many of the claimed elements of the invention with the exception of sliding at least one of the plurality of parts onto the cable and the plurality of parts being fixed to the cable at mounted position by an adhesive. Okamoto was cited for curing this deficiency. Claims 4 and 5 depend from claim 1. The Applicant traverses the rejection and respectfully submits that claims 4 and 5 recite subject matter that is neither disclosed nor suggested by the cited references.

Okamoto discloses a rubber grommet fixed to an electric wire 14 with adhesive tapes 12, 12 and inserted into a through hole 22 penetrating through a partition 20 to provide sealing between the electric wire 14 and an inner wall of the through hole 22. See the Abstract of Okamoto.

The Applicant respectfully submits that the combination of Cross and Okamoto fails to disclose or suggest the claimed features of the invention. As discussed above, Cross does not disclose or suggest mounting the plurality of parts to the cable. Okamoto merely discloses attaching a rubber grommet to an electric wire to seal the electric wire from an inner wall of a through hole. As such, Okamoto does not cure the deficiencies in Cross with respect to claim 1 and the combination of references fails to disclose or suggest the features of the invention as recited in dependent claims 4 and 5.

To establish a *prima facie* case of obviousness, each and every feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. § 2143.03.

In view of the above, the Applicant respectfully submits that the cited references fail to support a *prima facie* case of obviousness for purposes of a rejection of claims 4 and 5 under 35 U.S.C. § 103. Accordingly, claims 4 and 5 are not rendered obvious in view of the cited references and should be deemed allowable.

### **Conclusion**

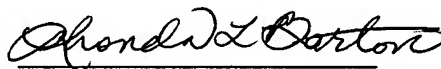
The Applicant respectfully submits that claim 1 is allowable for at least the reasons provided above. Claims 2-5 depend from claim 1. The Applicant further submits that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above. Accordingly, the

Applicant respectfully requests withdrawal of the rejections, allowance of claims 1-5 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107348-00358.**

Respectfully submitted,



Rhonda L. Barton  
Attorney for Applicant  
Registration No. 47,271

**Customer No. 004372**

ARENT FOX LLP

1050 Connecticut Avenue, N.W., Suite 400

Washington, D.C. 20036-5339

Tel: (202) 857-6000

Fax: (202) 638-4810

RLB/jjw:elp